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10/808,005	03/24/2004	Barbara E. Bear	1024-002U	4651

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CAREY, RODRIGUEZ, GREENBERG & PAUL LLP
ATTN: STEVEN M. GREENBERG, ESQ.
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

EXAMINER	
MCPHILLIP, ADRIAN J	
ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,005	BEAR, BARBARA E.	
	Examiner	Art Unit	
	Adrian J. McPhillip	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 18, 2009 has been entered.

2. This Non-Final Office Action is in response to Applicant's request for continued examination filed on June 18, 2009. Claims 1, 5 and 9 have been amended. Currently claims 1-9 are pending in this application.

Response to Arguments

3. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-9 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court precedent, and recent Federal Circuit decisions, *In re*

Bilski U.S. Court of Appeals Federal Circuit 88 USPQ2d 1385. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590.

5. The methods recited in claims 1-9 are neither tied to a machine nor do they transform the underlying subject matter to a different state or thing. See Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); and Gottschalk v. Benson, 409 U.S. 63, 71 (1972).

6. A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-9 fail to meet the above requirements because they are not tied to a particular machine nor do they transform the underlying subject matter to a different state or thing. Since the Applicant's method steps fail both prongs of the new Federal Circuit decision, claims 1-9 are non-statutory.

7. When amending claims 1-9, Applicant is reminded that nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary

for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. The Examiner respectfully suggests incorporating claim language that clearly recites the structure necessary for performing the Applicant's claimed method without adding new matter to the claims. For example, terms like processor, memory etc. could be explicitly tied to the method steps, so long as such terms are supported by the specification, to better help the claims comply with the statute. In the case of claim 1 for example a method comprising electronically receiving, generating, communicating [….] by a processor etc.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami (US 20020019755 A1) in view of Waytena et al. (US 5978770 A) – hereinafter Waytena, and further in view of Examiner's Official Notice .

Regarding **claims 1 and 5**, Kagami discloses a computer-implemented automated interactive method for matching an open appointment to a client, comprising:

- electronically generating a client list of the at least one client requesting a different appointment from an already scheduled appointment (see paragraph 25 wherein at least one customer is electronically identified to require a different scheduled appointment and paragraph 32 wherein customers enter an identification number after which the system searches its records for stylists who that customer has patronized before based on the identification number. The system therefore keeps records of previous appointments that the customer has scheduled, with specific stylists, and uses this information to present the customer with a list of available appointment times, with one of said stylists, that differ from the previously scheduled appointments in the system's records.);
- electronically generating an appointment list of at least one open appointment time slot (see paragraph 25 wherein a list of available appointments is generated for customers with conflicting appointments);
- correlating said client list to said appointment list to generate a contact list, said contact list containing at least one appointment option based on said at least one client and said at least one open appointment time slot (see paragraph 25 wherein at least one open appointment option is identified by correlating the schedules of the client and the stylist);

- electronically communicating said at least one appointment option to said at least one client, said at least one appointment option having a time of availability different than said scheduled appointment (see paragraph 25 wherein an appointment option with a different time availability is communicated to the client); and
- electronically selecting said at least one appointment option by said at least one client to fill said at least one open appointment time slot (see paragraph 39 wherein the system electronically fills the open slot with the client's appointment and sends a confirmation message).

Kagami does not explicitly teach in exact words that the method includes: electronically receiving at least one request for at least one client to change an already scheduled but not yet fulfilled appointment for the at least one client, or that the client list accordingly includes clients requesting a different appointment from an already scheduled but not yet fulfilled appointment.

The Applicant admits in paragraph [0006] of the specification that it was well known at the time of the invention that, "it is often necessary that an individual scheduled for an appointment with an office be required to cancel an appointment or reschedule the appointment to a different time." This statement suggests that the Applicant, and further one of ordinary skill in the art, was aware at the time of the invention of at least the need to allow an individual scheduled for an appointment with an office to cancel the appointment or reschedule the appointment to a different time. Furthermore, the Examiner hereby takes official notice that both manual and electronic methods of addressing this need were well known, to those of ordinary skill in the art, at the time of the invention. For example if a client needed to reschedule an already scheduled but not yet fulfilled doctor's appointment, it was well known for him/her to

call/contact the doctor's office in some way to try to reschedule the appointment. Additionally, US Patent No. 5289531 discloses an electronic re-scheduler for promptly and efficiently rescheduling appointments, wherein a client requests an appointment change by indicating availability and the system responds by presenting a plurality of re-scheduling options (see Abstract). For at least the aforementioned reasons it is the Examiner's position that the missing limitations of Kagami were well known to those of ordinary skill in the art at the time of the invention, as evidenced by US Patent No. 5289531.

In KSR, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." In this case the combination of the appointment scheduling method disclosed by Kagami and the well known method of facilitating a client's request to cancel or change an already scheduled but not yet fulfilled appointment, for example as disclosed by US Patent No. 5289531 would yield a predictable result. Specifically the result of combining the aforementioned known elements would be a method of scheduling an appointment that allowed clients to electronically schedule appointments using client lists in the manner disclosed by Kagami, but also allowed clients to reschedule or cancel an already scheduled but not yet fulfilled appointment according to well known techniques, including those explicitly disclosed by Kagami and US Patent No. 5289531. It would have been obvious to one of ordinary skill in the art to modify the method disclosed by Kagami to further include the functionality allowing clients to cancel or reschedule appointments

that are already scheduled but not yet fulfilled, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Regarding **claims 3 and 7**, Kagami discloses a computer-implemented automated interactive method for matching an open appointment to a client wherein said electronic communication of said at least one appointment option to said at least one client is by telephone (see paragraph 17 wherein the disclosed system utilizes a telephone to facilitate electronic communication).

Regarding **claims 4 and 8**, Kagami discloses a computer-implemented automated interactive method for matching an open appointment to a client wherein said electronic communication of said at least one appointment option to said at least one client is by electronic mail (see claims 12 and 13 wherein appointment information is exchanged via e-mail).

11. Claims 2, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami (US 20020019755 A1) in view of Examiner's Official Notice and further in view of Waytena et al. (US 5978770 A) – hereinafter Waytena.

Regarding **claims 2 and 6**, Kagami discloses a computer-implemented automated interactive method for matching an open appointment to a client but fails to teach the method further comprising: removing said selected at least one appointment option from said contact list; canceling said scheduled appointment of said at least one client; and placing said cancelled

appointment in said appointment list. However, it was well known to one of ordinary skill in the art at the time of the invention to remove said selected at least one appointment option from said contact list, and official notice is hereby taken to that effect. It is well known for working scheduling systems to have some method of tracking the appointments that it has already booked to avoid double booking clients. Usually as soon as an empty slot is filled it is removed from the list of available appointments so that it cannot be issued to a second client; this constitutes the type of basic functionality that can be found in almost any effective scheduling program.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the method of Kagami to include the limitation of removing said selected at least one appointment option from said contact list, in order to keep the database of available appointments as current as possible, which in turn would minimize the occurrence of double-bookings and increase the efficiency of the system in general.

With respect to the remaining two limitations of claim 2, Waytena et al. does disclose a method further comprising:

- canceling said scheduled appointment of said at least one client (see paragraphs 16-17 wherein patrons are able to cancel their reservations); and
- placing said canceled appointment in said appointment list (see paragraph 16 wherein canceled appointments are released back into the appointment list).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to further modify the method of Kagami to include that of Waytena et al. in order to keep the database of available appointments as current as possible. This would increase the efficiency of the scheduler by allowing it to fill recently cancelled, empty appointments as soon

as they become available, predictably resulting in a far more dynamic and useful embodiment of the invention, since such modifications could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding **claim 9**, Kagami discloses a computer-implemented automated interactive method for matching an open appointment to a client, comprising:

- electronically generating a client list of at least one client having a scheduled appointment, said at least one client requiring a different appointment than said scheduled appointment (see paragraph 25 wherein at least one customer is electronically identified to require a different scheduled appointment);
- electronically generating an appointment list of at least one open appointment time slot (see paragraph 25 wherein a list of available appointments is generated for customers with conflicting appointments);
- correlating said client list to said appointment list to generate a contact list, said contact list containing at least one appointment option based on said at least one client and said at least one open appointment time slot (see paragraph 25 wherein at least one open appointment option is identified by correlating the schedules of the client and the stylist);
- electronically communicating said at least one appointment option to said at least one client, said at least one appointment option having a time of availability different than said scheduled appointment (see paragraph 25 wherein an appointment option with a different time availability is communicated to the client);

- electronically selecting said at least one appointment option by said at least one client to fill said at least one open appointment time slot (see paragraph 39 wherein the system electronically fills the open slot with the client's appointment and sends a confirmation message);
- wherein a rejected appointment option is electronically communicated to a second client, and wherein a cancelled appointment is electronically communicated to said second client (see paragraph 27 wherein appointments are waitlisted and secondary clients are contacted when an appointment is canceled or rejected);

Kagami does not explicitly teach in exact words that the method includes: electronically receiving at least one request for at least one client to change an already scheduled but not yet fulfilled appointment for the at least one client, or that the client list accordingly includes clients requesting a different appointment from an already scheduled but not yet fulfilled appointment.

The Applicant admits in paragraph [0006] of the specification that it was well known at the time of the invention that, "it is often necessary that an individual scheduled for an appointment with an office be required to cancel an appointment or reschedule the appointment to a different time." This statement suggests that the Applicant, and further one of ordinary skill in the art, was aware at the time of the invention of at least the need to allow an individual scheduled for an appointment with an office to cancel the appointment or reschedule the appointment to a different time. Furthermore, the Examiner hereby takes official notice that both manual and electronic methods of addressing this need were well known, to those of ordinary skill in the art, at the time of the invention. For example if a client needed to reschedule an already scheduled but not yet fulfilled doctor's appointment, it was well known for him/her to

call/contact the doctor's office in some way to try to reschedule the appointment. Additionally, US Patent No. 5289531 discloses an electronic re-scheduler for promptly and efficiently rescheduling appointments, wherein a client requests an appointment change by indicating availability and the system responds by presenting a plurality of re-scheduling options (see Abstract). For at least the aforementioned reasons it is the Examiner's position that the missing limitations of Kagami were well known to those of ordinary skill in the art at the time of the invention, as evidenced by US Patent No. 5289531.

In KSR, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." In this case the combination of the appointment scheduling method disclosed by Kagami and the well known method of facilitating a client's request to cancel or change an already scheduled but not yet fulfilled appointment, for example as disclosed by US Patent No. 5289531 would yield a predictable result. Specifically the result of combining the aforementioned known elements would be a method of scheduling an appointment that allowed clients to electronically schedule appointments using client lists in the manner disclosed by Kagami, but also allowed clients to reschedule or cancel an already scheduled but not yet fulfilled appointment according to well known techniques, including those explicitly disclosed by Kagami and US Patent No. 5289531. It would have been obvious to one of ordinary skill in the art to modify the method disclosed by Kagami to further include the functionality allowing clients to cancel or reschedule appointments

that are already scheduled but not yet fulfilled, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Kagami additionally fails to explicitly teach the method comprising: removing said selected at least one appointment option from said contact list; canceling said scheduled appointment of said at least one client; and placing said cancelled appointment in said appointment list. Official notice is hereby taken to the effect that it was well known to one of ordinary skill in the art, at the time of the invention, to remove said selected at least one appointment option from said contact list. It was well known for working scheduling systems to have some method of tracking the appointments that it has already booked to avoid double booking clients. Usually as soon as an empty slot is filled it is removed from the list of available appointments so that it cannot be issued to a second client; this constitutes the type of basic functionality that can be found in almost any effective scheduling program.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to further modify the method of Kagami to include the limitation of removing said selected at least one appointment option from said contact list, in order to keep the database of available appointments as current as possible, which in turn would minimize the occurrence of double-bookings and increase the efficiency of the system in general.

With respect to the remaining two limitations of claim 9, Waytena discloses a method comprising:

- canceling said scheduled appointment of said at least one client (see paragraphs 16-17 wherein patrons are able to cancel their reservations); and
- placing said canceled appointment in said appointment list (see paragraph 16 wherein canceled appointments are released back into the appointment list).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to further modify the method of Kagami to include the steps disclosed by Waytena in order to keep the database of available appointments as current as possible. This would increase the efficiency of the scheduler by allowing it to fill recently canceled, empty appointments as soon as they become available, predictably resulting in a far more dynamic and useful embodiment of the invention. Since such modifications could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor the risk of unexpected results, the modifications have been deemed obvious.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian J. McPhillip whose telephone number is (571)270-5399. The examiner can normally be reached on Monday to Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. J. M./
Examiner, Art Unit 3623

9/24/2009

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623